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OFFICE OF PETITIONS

In re Application of :
Galperin et al. :
Application Number: 09/942983 : ON PETITION
Filing Date: 08/30/2001 :
Attorney Docket Number: :
EXP.046A :
:

This is a decision in reference to the petitions filed on 19 September, 2007, which are treated as (a) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.48(a) in that a person sought to be added as a named inventor will not sign the statement of lack of deceptive intent; (b) a petition under 37 CFR 1.47(a) with regard to the person sought to be added a named inventor; and (c) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.64 which requires that a named inventor execute a supplemental declaration.

The petition is **DISMISSED**.

Applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a), 1.183 and 1.48," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

On 30 August, 2001, the above-identified application was filed. On 3 December, 2001, a declaration in compliance with 37 CFR 1.63 was filed, naming Yuri Galperin, Vladimir Fishman, and William E. Eginton as joint inventors.

On 19 September, 2007, the present petitions were filed. Petitioners request that Charles L. Jones, III be added as a named inventor under 37 CFR 1.48(a). Petitioners further request

waiver under 37 CFR 1.183 of 1.48(a) in as much as Jones refuses to sign the statement of lack of deceptive intent and the declaration under 37 CFR 1.63. A petition under 37 CFR 1.47(a) is requested in that the inventor sought to be added, Jones, refuses to sign the declaration under 37 CFR 1.63 naming the inventive entity. Lastly, petitioners also request waiver under 37 CFR 1.183 of 1.64 in that a named inventor, William Eginton, refuses to execute the supplemental declaration naming him as a joint inventor along with Yuri Galperin, Vladimir Fishman, and Charles L. Jones, III.

Petition Under 37 CFR 1.183 to Waive 1.48(a).

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

- (1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;
- (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;
- (3) the fee set forth in 37 CFR 1.17(i), and
- (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

With regard to the request to add Charles L. Jones, III, petitioners have provided the written consent of the assignee, and state that Jones' address is unknown and he could not be reached by email.

The petition lacks items (1) and (2).

With regard to item (1), suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

In order to request waiver of the rules with regard to 37 CFR 1.48(a), petitioner must show that Jones refused or could not be located to sign the statement of lack of deceptive intent.

Petitioners should send or give the statement of lack of deceptive intent to Jones along with the application, as described in the paragraphs pertaining to 37 CFR 1.47(a), *infra*, in order to show Jones has refused or is unavailable to sign the statement of lack of deceptive intent.

Petitioners may show proof that a copy of the supplemental declaration was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the supplemental declaration to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

With regard to item (2), as discussed *infra*, the declaration is defective in that it does not include the residence and mailing address for all of the inventors as required by 37 CFR 1.63.

Petition Under 37 CFR 1.47(a).

Petitioners state, via the declaration of Laura Meltzer, executive assistant, that she telephoned Jones at his last known mobile phone number, but that he did not answer the phone and did not return any phone calls.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1), (2), and (5).

In regards to item (1), petitioners have not provided proof that the non-signing inventor was sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ Specifically, a showing must be provided that a copy of the application (specification, including

¹ MPEP 409.03(d).

the claims, drawings, if any, and the declaration) was provided to the non-signing inventor or his attorney, asking that the inventor review the application papers and sign and return the declaration.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details. In this case, petitioners should also send the copy of the statement of lack of deceptive intent pursuant to 37 CFR 1.48(a), as stated above.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

If the envelope sent to the non-signing inventor at the last known address is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application was returned as undeliverable with any renewed petition. If the inventor refuses in writing to sign, a copy of that written refusal should be provided with any renewed petition. If the inventor refuses orally, petitioners should submit details of the refusal in an affidavit or declaration of facts by a person having first-hand knowledge of the refusal.

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

With regard to item (2), the oath or declaration is insufficient because it does not list the residence city and state or city and foreign country for Egington and Jones as required by 37 CFR 1.63. The oath or declaration must identify the city and either state or foreign country of residence of each inventor.

A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by the inventor to whom the error or deficiency

relates is required.² As all of the signing inventors must sign, on behalf of a non-signing inventor under 37 CFR 1.47(a), a new declaration, containing the omitted residence and signed by all of the signing inventors on behalf of themselves and the non-signing inventor, must be filed with a renewed petition.³

As such, petitioners should provide a new oath or declaration, signed by all of the signing inventors on behalf of themselves and the non-signing inventors, including the citizenship, residence, and mailing address of all of the inventors.

With regard to item (5), petitioners do not state the last known address of the non-signing inventor. An application filed pursuant to 37 CFR 1.47 must state the last known address of the nonsigning inventor. That address should be the last known address at which the inventor customarily receives mail. See MPEP § 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor. Inasmuch as a nonsigning inventor is notified that an application pursuant to 37 CFR 1.47 has been filed on his or her behalf, other addresses at which the nonsigning inventor may be reached should also be given.⁴

If necessary, petitioner may wish to consider telephone or Internet searches in order to determine a last known address for Jones.

Petition Under 37 CFR 1.183 to Waive 37 CFR 1.64.

With regard to the petition requesting waiver of the requirement that William Eginton sign the supplemental declaration under 37 CFR 1.63, this application bears an original Declaration executed by joint inventor Eginton, and thus, the provisions of 37 CFR 1.47 do not apply with regard to Eginton's signature. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

As stated *supra*, suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities

² 37 CFR 1.67(a)(2).

³ See MPEP 409.03(A).

⁴ MPEP 409.03(e).

that would require suspension of the rules in the interests of justice.

In her declaration of facts, Laura Meltzer states that she attempted to contact Eginton by e-mail, but did not receive a response and has no last known address for him.

The petition must be dismissed because petitioners have not shown proof that the non-signing inventor acknowledged receipt of the emailed documents and was able to read them. Petitioners are reminded that 37 CFR 1.63 requires the inventor to state that he or she has reviewed and understands the contents of the application.

The transmission of documents via Email, while a common practice, can be problematic. Transmission and receipt of documents-whether in image, word-processing, spreadsheet or other form-can be affected by differences in software generation between the sender and recipient(s), and other interferences include but are not limited to sender's and recipient's Internet service provider's (ISP) and/or office/personal security firewall systems.

Thus, in the absence of an express statement from a non-signing inventor(s) that he/she/they have received, opened and read a document, unlike a printed page in the language of the recipient there is as of this writing no basis to presume that an Emailed document was in a form that can be read and comprehended.

Petitioners may show proof that a copy of the supplemental declaration was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the supplemental declaration to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Petitioners should send or give a copy of the supplemental declaration to Eginton at his last known address. If necessary, petitioner may wish to consider telephone or Internet searches in order to determine an address for Eginton. As stated *supra* in the section pertaining to 37 CFR 1.47(a), a copy of the declaration naming the actual inventors should be sent or given to Eginton. If Eginton refuses to sign the declaration or cannot be found, petitioners may show proof of refusal or diligent efforts to contact Eginton as stated above.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed
to the undersigned at 571-272-3231.


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